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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/896,174	06/29/2001	Kevin Paul Downes	159.1.847	9551

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EXAMINER	
HENDERSON, MARK T	
ART UNIT	**PAPER NUMBER**
3722	

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/896,174	DOWNES ET AL.	
	Examiner	Art Unit	
	Mark T Henderson	3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 November 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1, 3-8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 1 has been amended for further examination. Claim 2 has been canceled.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 3-8 are finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

2. Claim 1 recites the limitation "the player" in line 11; and "the prize" in line 13. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1 and 3-8 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al.

Walker et al discloses in Fig. 2, a lottery ticket comprising a first game area (120) on a row having a first end (right side of block 120E) containing play indicia; a second game area (130) on a row (130E) and the same number of rows as the first game area (120) and being adjacent the first end of the corresponding row of the first game area; a prize area (140)

comprising prize designations for the row of the first game, wherein a player may win the prize designation set forth in the prize area; and a means for selecting the first game area and second game are to see if a prize is won.

However, Walker et al does not disclose target indicia; wherein the first game area has a plurality of rows, and wherein the play indicia appear on a face of a dice; wherein the second game area has a plurality of rows; wherein the first game area has from 3 to 6 play indicia present therein; a means for selecting each of the rows in the first and second game area; and a third play area for designating a bonus prize, additional play numbers, additional target indicia or a multiplying feature.

In regards to **Claims 1**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate as many rows, play indicia, and means for selecting each of the rows for each game area as desired by the end user, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. Therefore, it would have been obvious to include as many game are a rows and play indicia on the playing card, since applicant has not disclosed the criticality of having a particular number of playing indicia, and invention would function equally well with any desired playing number.

In regards to **Claims 1, 3 and 6**, wherein the second game area designates a target indicia which if present in only the corresponding adjacent row of the first game area may result in a prize being won; wherein first game area play indicia corresponds to the target indicia form the corresponding adjacent row of the second game area; wherein the indicia of the first game area

are combined to obtain the target indicia in the second game area; and wherein the target indicia in the second game area are obtained by combining at least two play indicia from the first game area, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, the indicia in the first and second game area is capable of being obtained in any desirable manner.

In regards to **Claims 1, 4 and 5,** it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate any type of indicia as play indicia since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of gaming card does not alter the kind of functional relationship necessary for patentability. Therefore, it would have been obvious to place any type of background play indicia such as dice or cards, since applicant has not disclosed the criticality of having the background play indicia, and invention would function equally as well with any indicia.

Response to Arguments

4. Applicant's arguments filed on March 4, 2004 have been fully considered but they are not persuasive.

In response to applicant's arguments that the prior art does not disclose or suggest that prior art "does not provide for the three game areas required in the reference ticket" and that only "two games areas are provided and multiple games are played", the examiner submits that the Walker et al reference does indeed disclose a lottery ticket having a first game area, second game area, and a prize area. Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate as many rows, play indicia, and means for selecting each of the rows for each game area as desired by the end user, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. Therefore, it would have been obvious to include as many game are a rows and play indicia on the playing card, since applicant has not disclosed the criticality of having a particular number of playing indicia, and invention would function equally well with any desired playing number. Applicant must further disclose the placement of each game area and game. Applicant may wish to disclose that each game is placed on only one row location with each additional game being on a directly adjacent row, and further wherein each row is played.

Therefore, the examiner's rejection has been maintained.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.

MTH

A. L. WELLINGTON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700

January 16, 2005